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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER
NGUYEN, C

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____3____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Jun 8, 2001*

2a) ☒ This action is **FINAL.**   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-86* is/are pending in the application.

    4a) Of the above, claim(s) *1-46* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *47-86* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

    a) ☐ All b) ☐ Some* c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    *See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

DETAILED ACTION

1.   This Office Action is the answer to the communication received on 06/08/2001.

2. Claims **1-86** are pending in this application; claims 1-46 were canceled.

3.   Acknowledgment is made of applicant's claim for domestic priority US Patent 6,052,672 (filing date: 8/01/1997).

Response to Amendment

Applicant's arguments received on 6/08/2001 have been fully considered but they are not persuasive with previous cited references for 35 U.S.C.103(a) rejections.   The prior rejections on 35USC 112, 2nd para., and 35 USC 101 are withdrawn due to claims' amendments.

Accordingly, **THIS ACTION IS MADE FINAL.**   See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action.   In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action.   In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Case laws that are pertinent to this examination:

4. In re **Hiniker Co.**, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998), the court ruled: "The name of the game is the claim."

5. Although operational characteristics of a system may be apparent from the specification, we will not read such

characteristics into the claims when they cannot be clearly connected to the structure recited in the claims. See **In re Self**, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). When given their broadest reasonable interpretation, the claims on examination sweep in the prior art, and the prior art would have directed an artisan of ordinary skill to make the combination cited by the examiner. See also **Giles Sutherland Rich**, Extend of Protection and Interpretation of Claims -- American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499 (1990); ("The US is strictly an examination country and the main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. To coin a phrase, the name of the game is the claim").

6. In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Burt et al. contribute a support method/system with related functions including financial transaction functions, although not expressly suggested the

phrase of: "creating related records to allow pricing transaction" (see Burt et al., '482 Fig.5; col.30 lines 7-16). Doktor obviously modifies what Burt et al. 's missing in claimed limitation (see '899 claims 1, 6-7, Figs. 4A-B, 6B, 10). That published knowledge is a motivation for a particular "pricing transaction" purpose, it is in the knowledge generally available to one of ordinary skill in the art; moreover, the examiner submits that "production service instant" and "billing service instant" in claims merely are examples of well-known financial services (e.g., banks charge service for an extra monthly statement from ATMs, banks charge for transferring cash to a foreign bank due to a request of an account holder); these are financial services since there is nothing (in claims) to distinguish the claimed limitations with prior art.

On page 4, para.1, the applicant argues that Burt et al. fail to disclose "said production service instance being linked to said transaction instance by a first relation instance", and "said billing service instance being linked to said first production service instance by a second relation instance" as recited in claim 47. The term of "being linked" (as a key word) is an action in programming that is already defined below by Microsoft Press Computer Dictionary .

8.   On page 4, para.3, the applicant argues that Claus et al. do not remedy the deficiencies of Doktor and Burt et al., the examiner submits that "Categorization of purchased items for each transaction by a smart card" had been discussed by Claus et al.; and this subject matter as "categorized/classified purchased items" is considered as related to transaction as a whole (See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

9.   The MicroSoft Computer Dictionary defines the meaning of a database wherein data components are linked together within that

database as followings: linked list: In programming, a list of nodes or elements of a data structure connected by pointers. A singly linked list has one pointer in doubly linked list has two pointes in each node pointing to the next and previous nodes. In a circular list, the first and last nodes of the list are linked together; and link: To produce an executable program from compiled modules (programs, routines, or libraries) by merging the object code (assembly language object code, executable machine code) of the program and resolving interconnecting references (such as a library routine called by a program), or to connect two elements in a data structure by using index variables (index: A listing of keywords and associated data that point to the location of more comprehensive information, such as files and records on a disk/record keys in a database), or pointer variables (pointer: In programming and information processing, a variable that contains the memory location (address) of some data rather than data itself). The act of linking data from different parts in a database is fundamentally inherently in cited references/applications of Burt et al., Doktor, Rothstein, Clause et al., and they are a fundamental knowledge in database structure; from that available computer programming knowledge the applicant uses it to apply for a specific use (i.e. for pricing transactions). Therefore, <u>claim 47 is not teaching any new inventive concept according to cited references</u>.

10. The examiner considers claim 47 as:

A method for pricing transactions, comprising:

- **creating a database with different instances** (e.g. a transaction instance, a production service instance, a billing service instance); these instances are linked by relation instances.

With such interpreting of claiming limitations, this claim is incomplete and 35 USC 112, 2nd para., is proper (content of applicant's specification is not used as evidence that the scope

of the claims is consistent with the subject matter which

applicant regards as his invention); the examiner submits that

pre-computer and post-computer process activities are required

for this claimed method; see "The PTO Guidelines For Examination

Procedures For Computer-Related Invention", published in 1996).

The examiner submits that above reasonable interpretation of

claims 47, and 68 are fundamental concepts for a database

structure, and this is well-known. Therefore, cited references

are obviously/inherently utilized this defined fundamental

concept for their specific applications (e.g., relational

database).

- Independent claim **68** recites a data processing system that

   comprises a means for creating a transaction instance, a

   means for creating a production service instance, and the

   linking between the two instances. Thus it is also rejected

   for the same rationale and references of Burt et al.,

   Doktor, and Claus et al.

11. Applicant arguments on pg. 4 (2nd. Para.) should take In re
Van Geuns into consideration:

   Although the claims are interpreted in light of the
specification, limitations from the specification are not read
into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26
USPQ2d 1057 (Fed. Cir. 1993).

12. On page 5, the applicant quotes:

"The Official Notice is taken here that these following
definitions suggested in claims are well-known:
- an entity instance could be defined as a client instance.
- an entity instance could be defined as a market segment
instance...

13.   The examiner again submits that all claimed limitations are
well-known since instances for pricing transactions always "link"
to related objects in computer-related applications, because
these claimed limitations are very broad that they are easily
recognized by artisan in the art to be implemented in a computer
system via software programs; cited prior art's limitations are
not necessary spelled-out exactly claimed languages. As the
examiner presents that the claimed subject matter is obvious with
one of skills in the art, different instances in above claims may
be defined according to the use of a particular instance in
object-oriented programming, in relation to the class to which it
belongs; in other words, instance variable is just a variable
associated with an instance of a class (an object such as:
client, market segment .etc.).

14.   The following rejections are based on the examiner's
broadest reasonable interpretation of the claims; *In re Pearson,*
181 USPQ 641 (CCPA 1974).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C.§103(a), which

forms the basis for all obviousness rejections set forth in this

Office Action:

(a) A patent may not be obtained though the invention is not identically
disclosed or described as set forth in section 102 of this title, if the
differences between the subject matter sought to be patented and the prior
art are such that the subject matter as a whole would have been obvious at
the time the invention was made to a person having ordinary skill in the
art to which said subject matter pertains. Patentability shall not be
negatived by the manner in which the invention was made.

15. Claims **47-86** are rejected under 35 U.S.C. §103(a) are

rejected under 35 U.S.C. §103(a) as being unpatentable

over Claus et al. (US Pat. 5,559,313), in view of Burt et

al. (US Pat. 5,682,482), further in view of Doktor (US

Pat. 5,604,899), in view of Rothstein (US Pat.

5,636,117), in view of Claus et al. (US Pat. 5,559,313),

and further in view of Moore et al. (US Pat. 5,630,127).

A. Burt et al. disclose a support method/system with related

function including financial transaction functions (e.g. see

'482 the abstract), comprising steps/means:

- creating a transaction instance corresponding to a

financial transaction (e.g. see '482, the abstract, col.6 lines

1-14, and col.21 lines 42-59)(for claims **47, 68**);

Burt et al. do not expressly show that: service instances

linking to transaction instances; creating a billing service

instance linked to a service instance with relation instance (for

claim **47**), and an entity instance can be an account instance (for

claims **64, 85**).

However, Doktor (US Pat. 5,604,899) obviously suggests these above steps (e.g. see '899 claims 1, 6-7, Figs. 4A-B, 6B, 10; or e.g. '482 Fig.5; col.30 lines 7-16). Doktor also suggests a step of creating a relation instance linking a transaction instance to an account instance (e.g. see '899 Figs. 4B, 6A, and 6B); and

Rothstein ('117) obviously suggests that a market segment instant is an entity instant (for claim **55**)(e.g. see '117 col.2 lines 8-10, and lines 54-57, col.3 lines 9-12); and

Moore et al. ('127) obviously suggests a step of storing a transaction instance/an account instance/a client instance, a production service instance, a settlement service instance, and a billing service instance in an entity instance table, and they are inherently "link"/"relate" together as a functional data structure (e.g. see '127 Fig.4, and col.10 lines 25-55)(claims **48-51, 58, 69-75, 78, 83**).

The examiner submits that a price table instance could be defined as a cost table instance (claim **60, 80**), and said price is a cost; or a price table instance can be defined as a table instance, and said price is a fee (claims **61, 81**), whether they are expressed in different formats. Doktor ('899) obviously suggests a step of creating a cost table instance related to a fee table instance by a relation instance (claims **62, 82**); and an entity instance can be an account instance (e.g. see '899 col.30 lines 7-16).

Claus et al., further express that similar concept. Below are two general limitations in (claims **64, 66, 85, and 55**)

- an entity instance would be interpreted as a client instance;

- an entity instance would be interpreted as a market segment instance.

The examiner submits that all claimed limitations are known since instances for pricing transactions mostly "link" to related objects in computer-related applications, because these claimed limitations are very broad that they are easily recognized by artisan in the art to be implemented in a computer system via software programs; cited prior art's limitations are not necessary spelled-out exactly claimed languages. It is reasonable that various modifications and variations of the described method and system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although cited prior art disclosures have been described in connection with specific preferred embodiments, it should be understood that their subject matter should not be unduly limited to such specific embodiments.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to implement Doktor 's method/apparatus in specific applications of Burt et al., Rothstein, Claus et al., and further in Moore et al. in financial transaction because they all suggest a systematic method to track all of the components of costs and fees each time a financial transaction is processed. It is recognizable that a finance system would be able to measure profitability in a

flexible manner and to measure the impact of any changes from

banking clients.

B. Ref. to claims **76-77/56-57**: In addition, Doktor obviously

suggests of storing/retrieving relation instances in relation

instance table (e.g. see '899 Fig. 9.1 and claim 5); and creating

a second entity instance related to first entity instance (e.g.

see '899 Fig. 4A).

C.   Re. to claims **79/59, 83/63, 65/84**:

The rationales for rejection of claims 47/68 are incorporated

herein.

Claus et al. ('313) obviously suggests a means for creating

a price table instance related to a transaction instance; the

examiner submits that the phrase "wherein said price table

instance contains a price for said billing service instance" is

obviously interpreting above under-lined key words meaning (e.g.

see '313 Fig.6).

Therefore, it would have been obvious to one of ordinary

skill in the art at the time of invention to implement Doktor 's

method/apparatus in specific applications of Burt et al.,

Rothstein, Claus et al., and further in Moore et al. in

financial transaction because they all suggest a systematic

method to track all of the components of costs and fees each

time a financial transaction is processed. It is recognizable

that a finance system would be able to measure profitability in a

flexible manner and to measure the impact of any changes from

banking clients.

D.   Re. to claims **47-67**: They are also rejected under 35 U.S.C.§103(a) because they are steps that using exactly means claimed in claims 68-86 with similar rationale and references.

Conclusion

16.   Claims **47-86** are rejected.

17.   The examiner submits that the reasons for rejection are obvious (vs. cited prior arts) with <u>claim language</u>. Applicant is suggested to indicate **in the claims how** the claims distinguish from the combining of cited prior arts.   An instance, as defined, can be any object in object-oriented programming in relation to the class to which it belongs; a definition for instance variable: a variable associated with an instance of a class (an object), if a class defines a certain variable, each instance of the class has its own copy of that variable. Hence, <u>there is nothing novel in defining/creating again different instances that linking together in a data structure (the definition is already established for an obvious/inherent use of "instance" in cited prior art)</u>.

18. *Ex parte* **Rubin**, 5 USPQ2d 1461 (BdPatApp&Int 1987), <u>the court said</u>:

Knowledge in the art may have advanced such that results considered incredible are no longer per se incredible.

19. *In re* **Heck**, 216 USPQ 1038 (Fed. Cir. 1983), the court said:

"The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems

with which they are concerned. They are part of the literature

of the art, relevant for all they contain."

20.   A statement of purpose or intended use in the preamble of a

claim must be considered if the language of a preamble is

necessary to give meaning to the claim" **Diversitech Corp. v.**

Century Steps, Inc., 7 USPQ2d 1315 (Fed. Cir. 1988); In re

Stencel, 4 USPQ2d 1071(Fed. Cir. 1987).

21. In re Susi, 169 USPQ 423 (CCPA 1971), the court said:

Disclosed examples and preferred embodiments do not constitute a

teaching away from a broader disclosure or non-preferred

embodiments.

22.   Any inquiry concerning this communication or earlier
communications from the examiner should be directed to examiner
Cuong H. Nguyen, whose telephone number is (703)305-4553. The
examiner can normally be reached on Monday-Friday from 7:00
AM-3:30 PM.

If attempts to reach the examiner by telephone are
unsuccessful, the examiner's supervisor, Ms. Wynn Coggins, can be
reached on (703)308-1344.

Any response to this action should be mailed to:
Amendments
Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231
or faxed to: (703) 308-9051/746-5572
Any inquiry of a general nature or relating to the status of
this application should be directed to the Group receptionist
whose telephone number is (703)305-3900.

Cuonghnguyen

Patent Examiner

August 17, 2001